

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Henrik Borjesson

Serial No.: 10/534,139

Filed: May 6, 2005

For: *Device And Method For Generating An Alert Signal*

Confirmation No.: 8489

Group Art Unit: 2617

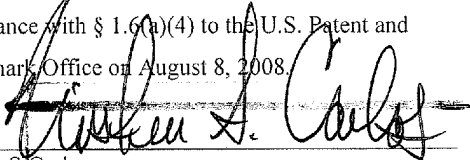
Examiner: Marcos L Torres

Date: August 8, 2008

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Kirsten S Carlos

APPELLANT'S BRIEF ON APPEAL UNDER 37 C.F.R. §41.37

Sir:

This Appeal Brief is filed pursuant to the "Notice of Appeal to the Board of Patent Appeals and Interferences" filed April 24, 2008 and the "Notice of Panel Decision from Pre-Appeal Brief Review" mailed July 8, 2008.

Real Party In Interest

The real party in interest is assignee Sony Ericsson Mobile Communications AB, Lund, Sweden.

Related Appeals and Interferences

Appellant is aware of no appeals or interferences that would be affected by the present appeal.

Status of Claims

Appellant appeals the rejection of Claims 1 – 8, 10 – 21, and 23 - 28 as set forth in the Final Office Action of January 25, 2008 (hereinafter "Final Action"), which as of the filing date of this Brief remain under consideration. Claims 1 – 8, 10 – 21, and 23 - 28 stand rejected. Claims 9 and 22 have been canceled. Appellant submits that the claims involved in the appeal are Claims 1 – 8, 10 – 21, and 23 - 28 as a reversal of the rejection of independent Claims 1 and 14 is requested in the present appeal and a reversal of the rejection of dependent Claims 2 – 8, 10 – 13, 15 – 21, and 23 - 28 is also requested based on the reversal of the rejection of the independent claims. Accordingly, Claims 1 – 8, 10 – 21, and 23 - 28 as included in Appellant's response to the Office Action of July 30, 2007 are attached hereto as Appendix A.

Status of Amendments

A "Reasons In Support Of Applicants' Pre-Appeal Brief Request For Review" was filed in response to the Final Action on April 24, 2008 in the present case.

Summary of Claimed Subject Matter

Independent Claim 1 is directed to a device for generating an alert signal comprising positioning means for updating and storing an actual position of the device (Specification, page 4, line 28 – page 5, line 1). The positioning means comprises location storage means for storing the location of a place of interest (Specification, page 5, lines 10 – 11), means for storing a request for an alert signal associated with the location of a place of interest (Specification, page 6, lines 8 – 24), first trigger means for comparing the actual position of the device with the location of the place of interest and triggering generation of said alert signal when the distance between the actual position of the device and the location of the place of interest is less than a predetermined value (r) (Specification, page 5, lines 18 – 25), calendar means for storing calendar entries (Specification, page 4, lines 20 -27 and page 6, lines 8 – 17), clock means for keeping track of the actual time (Specification, page 4, lines 20 -27 and page 6, lines 8 – 17), and second trigger means for comparing the actual time with a calendar entry and triggering generation of said alert signal when the actual time matches the calendar entry, but only when the distance between the actual position of the device and the location of the place of interest is less than the predetermined value (r)

(Specification, page 4, lines 20 -27 and page 6, lines 8 – 17). A mobile telephone may provide structure for the positioning means, location storage means, means for storing a request, first trigger means, calendar means, clock means, and second trigger means.

Independent Claim 14 is directed to a method for generating an alert signal in a device comprising storing an actual position of the device (Specification, page 4, line 28 – page 5, line 1), storing the location of a place of interest (Specification, page 5, lines 10 – 11), storing a request for an alert signal associated with the location of a place of interest (Specification, page 6, lines 8 – 24), comparing the actual position of the device with the location of the place of interest and triggering generation of said alert signal when the distance between the actual position of the device and the location of the place of interest is less than a predetermined value (r) (Specification, page 5, lines 18 – 25), storing calendar entries (Specification, page 4, lines 20 -27 and page 6, lines 8 – 17), keeping track of the actual time (Specification, page 4, lines 20 -27 and page 6, lines 8 – 17), and comparing the actual time with a calendar entry and triggering generation of said alert signal when the actual time matches the calendar entry, but only when the distance between the actual position of the device and the location of the place of interest is less than the predetermined value (r) (Specification, page 4, lines 20 -27 and page 6, lines 8 – 17).

Grounds of Rejection to be Reviewed on Appeal

Claims 1 – 4, 7, 12 – 17, 25, 26, and 28 stand rejected under 35 U.S.C. §102(b) as being anticipated by U. S. Patent No. 5,938,721 to Dussell et al. (hereinafter "Dussell"). (Final Action, page 3).

Claims 5 and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Dussell in view of U. S. Patent Publication No. US006799049 to Zellner. (Final Action, page 5).

Claims 6 and 19 - 21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Dussell in view of U. S. Patent Publication No. US006785552 to Shinozaki. (Final Action, page 5).

Claim 8 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Dussell in view of U. S. Patent Publication No. US005598166 to Ishikawa. (Final Action, page 6).

Claims 10, 11, 23, and 24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Dussell in view of U. S. Patent Publication No. US006317593 to Vossler. (Final Action, page 6).

Claim 27 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Dussell in view of U. S. Patent Publication No. US006950663 to Pihl. (Final Action, page 7).

Argument

I. Introduction to 35 U.S.C. §102 Analysis

Under 35 U.S.C. § 102, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

M.P.E.P. § 2131 (quoting *Verdegaal Bros. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987)). "Anticipation under 35 U.S.C. § 102 requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention." *Apple Computer Inc. v. Articulate Sys. Inc.*, 57 U.S.P.Q.2d 1057, 1061 (Fed. Cir. 2000). "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" M.P.E.P. § 2112 (citations omitted).

A finding of anticipation further requires that there must be no difference between the claimed invention and the disclosure of the cited reference as viewed by one of ordinary skill in the art. See *Scripps Clinic & Research Foundation v. Genentech Inc.*, 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). In particular, the Court of Appeals for the Federal Circuit held that a finding of anticipation requires absolute identity for each and every element set forth in the claimed invention. See *Trintec Indus. Inc. v. Top-U.S.A. Corp.*, 63 U.S.P.Q.2d 1597 (Fed. Cir. 2002). Additionally, the cited prior art reference must be enabling, thereby placing the allegedly disclosed matter in the possession of the public. *In re Brown*, 329 F.2d 1006, 1011, 141 U.S.P.Q.

245, 249 (C.C.P.A. 1964). Thus, the prior art reference must adequately describe the claimed invention so that a person of ordinary skill in the art could make and use the invention.

Appellant respectfully submits that the pending independent claims are patentable over the cited reference for at least the reason that the cited reference does not disclose or suggest each of the recitations of the independent claims. The patentability of the pending claims is discussed in detail hereinafter.

A. Independent Claims 1 and 14 are Patentable

Independent Claims 1 and 14 stand rejected under 35 U.S.C. §102(b) as being anticipated by U. S. Patent No. 5,938,721 to Dussell. (Final Action, page 3). Independent Claim 1 is directed to a device for generating an alert signal and recites, in part:

...
calendar means for storing calendar entries;
clock means for keeping track of the actual time; and
second trigger means for comparing the actual time with a calendar entry and triggering generation of said alert signal when the actual time matches the calendar entry, but only when the distance between the actual position of the device and the location of the place of interest is less than the predetermined value (r);
...

Independent Claim 14 includes similar recitations. According to the independent claims, the actual time may be tracked and an alert signal generated only when the distance between the device's position and the place of interest is less than a predetermined value **and** there is a match between the actual time and a calendar entry. This is described, for example, in the Specification at page 6, lines 8 – 17.

The Final Action cites the passages from Dussell at col. 7, lines 15 – 32 and col. 9, lines 10 – 15 in rejecting dependent Claim 9. (Final Action, page 3). The passage at col. 7, lines 15 – 32, however, explains that conventional scheduling programs provide an ability to store reminders in the form of "to-do" lists. The passage goes on to explain that the focus of Dussell's disclosure is to provide "a means by which tasks can be scheduled and/or prioritized based on location." (Dussell, col. 7, lines 23 – 24). The second passage cited in rejecting dependent Claim 9 at col. 9, lines 10 – 15 explains that the database 10, which includes the geocoded references, can be accessed by

various types application programs, such as calendaring and scheduling programs that run on the computer system 20. After reviewing these passages, Appellant submits that Dussell merely discloses the capability of generating an alert once a mobile device comes within a predetermined range of a defined geographic location. Dussell does not disclose or suggest modifying this capability to make the alert conditional on satisfying a time condition, such as a date on a calendar, for example. Appellant acknowledges that Dussell mentions that the geocoded references can be accessed by calendaring and scheduling programs at col. 9, lines 10 – 15. But when this excerpt is placed in context by reviewing the entire paragraph of which it is a part, the excerpt appears to be referring to the ability to program the geocoded references into the database 10 (Dussell, col. 9, lines 3 – 15). Appellant submits, therefore, that Dussell fails to disclose or suggest, at least, making a geographic alert conditional on a time condition as recited in independent Claims 1 and 14.

In response to this argument, the Final Action on page 2 points out that Dussell describes their disclosure as a "a means by which tasks can be scheduled and/or prioritized based on location." (Dussell, col. 7, lines 23 – 24). The Final Action further cites col. 7, lines 13 - 31 of Dussell as teaching that prioritization can be based on due dates. (Final Action, page 2). Appellant respectfully submits that these portions of Dussell taken in isolation do not provide an accurate representation of their meaning. The relevant passages from Dussell read as follows:

Typically, mobile computer system 20 will store various application programs, including a scheduling program which allows an operator to store reminders in the form of "To-Do" lists or other forms. Such scheduling programs are common in the art and often allow the user to prioritize tasks to be accomplished according to a variety of criteria, including due dates, etc. (Dussell, col. 7, lines 16 - 22).

Thus, Dussell first explains that conventional scheduling programs allow a user to prioritize tasks based on due dates and store reminders associated with the tasks. Dussell then proceeds to describe how their disclosure is different from the conventional art:

The present invention provides a means by which tasks can be scheduled and/or prioritized based on location. (Dussell, col. 7, lines 22 - 24).

Dussell explains that conventional systems prioritize tasks based on due dates, but their disclosure is different from conventional systems and is directed to scheduling/prioritizing tasks

based on location. To illustrate this distinction, Dussell provides an example that a task descriptor may be "PICK UP MILK" and the location reference may be "GROCERY STORE." When a user is near the grocery store, the "PICK UP MILK" task becomes a priority and the user is alerted. Dussell provides no mention that the geographic alert associated with being near the grocery store may also be conditional on some type of time condition. (Dussell, col. 7, lines 30 - 41). Accordingly, Appellant maintains that Dussell fails to disclose or suggest, at least, making a geographic alert conditional on a time condition as recited in independent Claims 1 and 14.

For at least the foregoing reasons, Appellant submits that independent Claims 1 and 14 are patentable over the cited reference and that dependent Claims 2 - 8, 10 - 13, 15 - 21, and 23 - 28 are patentable at least by virtue of their depending from an allowable claim. Accordingly, Appellant respectfully requests that the rejection of Claims 1 - 8, 10 - 21, and 23 - 28 be reversed based on the failure of the Examiner to establish a prima facie case of anticipation under 35 U.S.C. §102 for at least these reasons.

II. 35 U.S.C. §103 Rejections

A. Claims 5 and 18 are Patentable

Claims 5 and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Dussell in view of U. S. Patent Publication No. US006799049 to Zellner. (Final Action, page 5). Dependent Claims 5 and 18 depend from independent Claims 1 and 14, respectively, which Appellant submits are patentable for at least the reasons discussed above in Section IA. Appellant submits that dependent Claims 5 and 18 are patentable over the cited references at least by virtue of their depending from an allowable claim. *Ex parte Ligh*, 159 U.S.P.Q. (BNA) 61, 62 (Bd. App. 1967). Accordingly, Appellant respectfully requests that the rejection of Claims 5 and 18 be reversed based on the failure of the Examiner to establish a prima facie case of obviousness under 35 U.S.C. §103 for at least these reasons.

B. Claims 6 and 19 - 21 are Patentable

Claims 6 and 19 - 21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Dussell in view of U. S. Patent Publication No. US006785552 to Shinozaki. (Final Action, page 5).

Dependent Claims 6 and 19 – 21 each depend from one of the independent Claims 1 and 14, which Appellant submit are patentable for at least the reasons discussed above in Section IA. Appellant submits that dependent Claims 6 and 19 - 21 are patentable over the cited references at least by virtue of their depending from an allowable claim. *Ex parte Ligh*, 159 U.S.P.Q. (BNA) 61, 62 (Bd. App. 1967). Accordingly, Appellant respectfully requests that the rejection of Claims 6 and 19 - 21 be reversed based on the failure of the Examiner to establish a prima facie case of obviousness under 35 U.S.C. §103 for at least these reasons.

C. Claim 8 is Patentable

Claim 8 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Dussell in view of U. S. Patent Publication No. US005598166 to Ishikawa. (Final Action, page 6). Dependent Claim 8 depends from independent Claim 1, which Appellant submits is patentable for at least the reasons discussed above in Section IA. Appellant submits that dependent Claim 8 is patentable over the cited references at least by virtue of their depending from an allowable claim. *Ex parte Ligh*, 159 U.S.P.Q. (BNA) 61, 62 (Bd. App. 1967). Accordingly, Appellant respectfully requests that the rejection of Claim 8 be reversed based on the failure of the Examiner to establish a prima facie case of obviousness under 35 U.S.C. §103 for at least these reasons.

D. Claims 10, 11, 23, and 24 are Patentable

Claims 10, 11, 23, and 24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Dussell in view of U. S. Patent Publication No. US006317593 to Vossler. (Final Action, page 6). Dependent Claims 10, 11, 23, and 24 each depend from one of the independent Claims 1 and 14, which Appellant submits are patentable for at least the reasons discussed above in Section IA. Appellant submits that dependent Claims 10, 11, 23, and 24 are patentable over the cited references at least by virtue of their depending from an allowable claim. *Ex parte Ligh*, 159 U.S.P.Q. (BNA) 61, 62 (Bd. App. 1967). Accordingly, Appellant respectfully requests that the rejection of Claims 10, 11, 23, and 24 be reversed based on the failure of the Examiner to establish a prima facie case of obviousness under 35 U.S.C. §103 for at least these reasons.

E. Claim 27 is Patentable

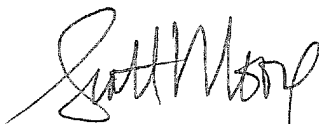
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Claim 27 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Dussell in view of U. S. Patent Publication No. US006950663 to Pihl. (Final Action, page 7). Dependent Claim 27 depends from independent Claim 14, which Appellant submits is patentable for at least the reasons discussed above in Section IA. Appellant submits that dependent Claim 27 is patentable over the cited references at least by virtue of their depending from an allowable claim. *Ex parte Ligh*, 159 U.S.P.Q. (BNA) 61, 62 (Bd. App. 1967). Accordingly, Appellant respectfully requests that the rejection of Claim 27 be reversed based on the failure of the Examiner to establish a prima facie case of obviousness under 35 U.S.C. §103 for at least these reasons.

III. Conclusion

In summary, Appellant respectfully submits that, with respect to Claims 1 – 8, 10 – 21, and 23 – 28, the cited references do not teach all of the recitations of the claims for at least the reasons discussed above. Accordingly, Appellant respectfully requests reversal of the rejection of Claims 1 – 8, 10 – 21, and 23 – 28 based on the cited reference.

Respectfully submitted,



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APPENDIX A

1. (Previously Presented) A device for generating an alert signal comprising:
positioning means for updating and storing an actual position of the device,
comprising:
location storage means for storing the location of a place of interest;
means for storing a request for an alert signal associated with the location of a place of interest;
first trigger means for comparing the actual position of the device with the location of the place of interest and triggering generation of said alert signal when the distance between the actual position of the device and the location of the place of interest is less than a predetermined value (r);
calendar means for storing calendar entries;
clock means for keeping track of the actual time; and
second trigger means for comparing the actual time with a calendar entry and triggering generation of said alert signal when the actual time matches the calendar entry, but only when the distance between the actual position of the device and the location of the place of interest is less than the predetermined value (r).
2. (Previously Presented) A device according to claim 1, wherein the predetermined value (r) is variable, and may be set individually for each request for an alert signal.
3. (Previously Presented) A device according to claim 1 wherein the location storage means comprises a personal map program.
4. (Previously Presented) A device according to claim wherein the location storage means comprises a browser for finding locations on a telecommunications network.
5. (Previously Presented) A device according to claim 4 wherein the browser is a WAP browser for finding locations on the Internet.

6. (Previously Presented) A device according to claim 1, wherein the positioning means further is configured to update the actual position of the device every time the device changes base station.

7. (Previously Presented) A device according claim 1, wherein the positioning means further is configured to update the actual position of the device at regular time intervals and/or every time the device has moved a distance.

8. (Previously Presented) A device according to claim 1, wherein the positioning means further is configured to update the actual position of the device in dependence of the speed of the device.

10. (Previously Presented) A device according to claim 1, wherein the calendar entry matches the actual time once only.

11. (Previously Presented) A device according to claim 1, wherein the calendar entry matches the actual time repeatedly for a specified time unit.

12. (Previously Presented) A device according to claim 1, wherein the positioning means comprises a GPS receiver.

13. (Previously Presented) A device according to claim 1, wherein the device is a portable telephone, a pager, a communicator, a smart phone, a positioning device or an electronic organiser.

14. (Previously Presented) A method for generating an alert signal in a device comprising:
storing an actual position of the device;
storing the location of a place of interest;
storing a request for an alert signal associated with the location of a place of interest;
comparing the actual position of the device with the location of the place of interest and triggering generation of said alert signal when the distance between the actual position of the device and the location of the place of interest is less than a predetermined value (r);
storing calendar entries;

keeping track of the actual time; and

comparing the actual time with a calendar entry and triggering generation of said alert signal when the actual time matches the calendar entry, but only when the distance between the actual position of the device and the location of the place of interest is less than the predetermined value (r).

15. (Previously Presented) A method according to claim 14 wherein the predetermined value (r) is variable, and is set individually for each request for an alert signal.

16. (Previously Presented) A method according to claim 14 wherein storing the location of the place of interest comprises storing the location of the place of interest by means of a personal map program.

17. (Previously Presented) A method according to claim 14, wherein storing the location of the place of interest comprises storing the location of the place of interest by means of a browser for finding locations on a telecommunications network.

18. (Previously Presented) A method according to claim 17, wherein the browser is a WAP browser for finding locations on the Internet.

19. (Previously Presented) A method according to claim 14, further comprising:
updating the actual position of the device every time the device changes base station.

20. (Previously Presented) A method according to claim 14, further comprising:
updating the actual position of the device at regular time intervals and/or every time the device has moved a distance.

21. (Previously Presented) A method according to claim 14, further comprising:
updating the actual position of the device based on a speed of the device.

23. (Previously Presented) A method according to claim 14, wherein the calendar entry matches the actual time once only.

24. (Previously Presented) A method according to claim 14, wherein the calendar entry

matches the actual time repeatedly for a specified time unit.

25. (Previously Presented) A method according to claim 14, wherein storing the actual position of the device comprises receiving GPS signals.

26. (Previously Presented) A method according to claim 14, wherein storing the actual position of the device comprises receiving position information from a mobile telecommunication network.

27. (Previously Presented) A method according to claim 26, wherein the mobile telecommunication network uses EOTD (Enhanced Observed Time Difference) or OTDOA (Observed Time Difference On Arrival).

28. (Previously Presented) A method according to claim 14, wherein the device is a portable telephone, a pager, a communicator, a smart phone, a positioning device or an electronic organiser.

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APPENDIX B – EVIDENCE APPENDIX

None

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APPENDIX C – RELATED PROCEEDINGS APPENDIX

None.